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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	78556095
Applicant	Alternative Processing Systems, Inc.
Applied for Mark	AT STORE RECLAMATION
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Submission	Appeal Brief
Attachments	Appeal Brief.pdf ( 10 pages )(61452 bytes ) Brief Exhibit A.pdf ( 4 pages )(171066 bytes ) Brief Exhibit B.pdf ( 2 pages )(90187 bytes )
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Date	12/18/2006

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of:

Alternative Processing Systems, Inc.

Serial No. 75/556,095

Filed: January 28, 2005

Mark: AT STORE RECLAMATION

**TRADEMARK LAW OFFICE: 115**

Trademark Attorney: Jeffrey S. DeFord

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2900 Crystal Drive  
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**BRIEF FOR APPELLANT**

**I. INTRODUCTION**

Applicant appeals from the Examining Attorney's final refusal to register Applicant's AT STORE RECLAMATION service mark ("Mark") on the grounds that the Mark is merely descriptive of a feature, function, use, benefit and/or characteristic of the Applicant's services and that the identification of services is unacceptable because the specific nature of the services is unknown. Applicant respectfully requests the Trademark Trial and Appeal Board ("TTAB") to reverse the Examiner's decision and pass the application to publication. Applicant has filed a timely Notice of Appeal. Applicant does not seek oral argument in this appeal.

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## II. DESCRIPTIVE REFUSAL

Applicant's mark should be registered because it is not *merely* descriptive because while it may suggest to the average prospective customer something about the features of Applicant's services, it also will function as an indication of origin for those services for the following reasons:

### A. Applicant's Mark is Registerable Because it is Suggestive As to the Nature of Applicant's Goods, Not Merely Descriptive of Them.

A descriptive mark describes a desirable characteristic, purpose, function, quality or use of any of the goods or services to which it is applied. A term is merely descriptive if it immediately describes an ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. Simply because a mark imparts information about the characteristics of the goods or services does not render it incapable of functioning as a trademark. *In re DC Comics, Inc.*, 215 U.S.P.Q. 394, 396 (CCPA 1982).

A mark is registerable if it requires elements of "imagination, thought and perception to reach a conclusion as to the nature of the goods." TMEP § 1209.01(a); see also *Stix Products, Inc. v. United Merchants & Mfr., Inc.*, 295 F. Supp. 479, 488, 160 U.S.P.Q. 477 (S.D.N.Y. 1968). The mark may then be termed suggestive and not descriptive. J. Thomas McCarthy, McCarthy's on Trademarks and Unfair Competition § 11:19 at 11-26 [hereinafter McCarthy's]. In *Council of Better Business Bureaus v. Better Business Bureau*, 200 U.S.P.Q. 282 (S.D. Fla. 1978), the court considered whether BETTER BUSINESS BUREAU was merely descriptive or whether it was suggestive:

From the Better Business Bureau name alone it is impossible to discern with certainty that Council and its members are concerned with the promotion of business ethics and truth in advertising. Some additional information and/or

imagination is needed to draw the conclusion. That is the very meaning of a suggestive mark. (Id. at 293).

Along the same lines, the Trademark Trial and Appeals Board stated, in *Airco, Inc. v. Air Products & Chemicals, Inc.*, 196 USPQ 832 (1977):

The mark AIR-CARE is, moreover, not merely descriptive as applied to applicant's services. The literal meaning of the mark, namely, "care of the air", may, through an exercise of mental gymnastics and extrapolation suggest or hint at the nature of applicant's services, but it does not, in any clear or precise way, serve merely to describe applicant's preventive maintenance services directed to a scheduled maintenance program for hospital and medical anesthesia and inhalation therapy equipment.

The determination of whether or not a mark is merely descriptive cannot be made in the abstract, but must consider the mark in relation to the goods for which registration is sought. TMEP § 1209.01(b).

In the present case, Applicant's Mark AT STORE RECLAMATION may be suggestive of an attribute of Applicant's service but it certainly does not, in any precipatory way, convey an idea as to what Applicant's services are. Nothing in the Mark indicates that Applicant's services pertain to reclamation of unsaleable grocery store products. It is impossible to discern from Applicant's Mark what Applicant's services are. The average consumer, upon seeing or hearing the words AT STORE RECLAMATION is required to use a degree of imagination or reflection, to "mentally pause" in order to deduce a quality or characteristic of the goods. The consumer, in fact, needs additional information to understand that the Mark is referencing an inventory control system for grocery store products and the other services provided within a system for reclamation of grocery store products, including regular visits, scanning and processing, store reporting, transportation and donation, disposal, accounting and reporting and customized coordination of collection of products. Consequently, the Mark is not merely descriptive.

**B. The Term At Store Reclamation Is Not Found In A Dictionary.**

The Examining Attorney has not cited any sources that indicate that Applicant's Mark, as a whole, is in common usage by others as a description of the same or related goods.

These words do not appear in a dictionary in this combination. Applicant could not find a definition for "AT STORE RECLAMATION" in any dictionary, scientific or otherwise.

Applicant also notes that a mark may be deemed suggestive if it conjures up two meanings or more (even though one meaning may be descriptive and the other suggestive), because the mark is then not merely descriptive. See Council of Better Business Bureaus. As previously indicated, subject Mark could describe a variety of inventory control systems and does not describe the services relative to different types of reclamation, different types of stores and different types of products. Given the variety of meanings, it is difficult to understand how the Mark can be deemed descriptive of defined characteristics.

**C. Applicant's Mark Will Be Used In A Trade Mark Manner To Identify The Origin Of The Services, Not To Describe Them.**

Applicant's use of the term AT STORE RECLAMATION will identify the source of Applicant's products. Applicant's use of the Mark will function as a trademark, and not as a descriptor. The Mark will clearly be presented to the public as an indication of origin, thus it is submitted that the Mark is not primarily descriptive.

**D. Applicant's Mark Evokes A Unique Commercial Impression.**

Finally, even where a combination mark consists of descriptive terms, the mark is not merely descriptive if the combination evokes an unique commercial impression. See, e.g., In re Colonial Stores, Inc., 394 F.2d 549 (CCPA 1968) (SUGAR & SPICE not merely descriptive of bakery products notwithstanding sugar and spice are ingredients of bakery products); In re Shutts, 217 U.S.P.Q. 363 (TTAB 1983) (SNO-RAKE not merely descriptive of snow removal

tool notwithstanding that it could be used to rake snow); In re Gourmet Bakers, Inc., 173 U.S.P.Q. 565 (TTAB 1972) (THE LONG ONE not descriptive of bread); In re Morton-Norwich Products, Inc., 209 U.S.P.Q. 791 (TTAB 1981) (COLOR CARE not descriptive for laundry bleach); In re McDonald's Corp., 199 U.S.P.Q. 490 (TTAB 1978) (TWO ALL BEEF PATTIES not descriptive for hamburger sandwich); American Home Products Corp. v. Johnson Chem. Co., 589 F.2d 103 (2nd Cir. 1978) (ROACH MOTEL not descriptive for cockroach trap).

In the present case, Applicant's Mark is substantially more suggestive than many if not all of the above-cited cases. The combination AT STORE RECLAMATION mark is not merely descriptive because the combination evokes a unique commercial impression.

Further, in considering the descriptiveness of a mark, the entire mark must be assessed. The mark must be considered in its entirety. It is improper to dissect a mark and separately analyze the individual words (as Examining Attorney has done in the Office Action) which it may incorporate. In re Hutchinson Technology, supra. Likewise, a combination of terms in a mark, each of which may be descriptive, may collectively result in a mark which is not descriptive. In re Carlson Technology Products, Inc., 197 U.S.P.Q. 44 (TTAB 1977).

**E. Competitors Do Not Need To Use Applicant's Mark To Describe Their Goods.**

The Mark is not being used by competitors to describe similar goods, nor would competitors be deprived of their ability to describe their goods by the registration of Applicant's Mark. Many other terms are available to competitors to promote their goods. Consequently, competitors will not suffer a hardship by the registration of these terms.

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**F. Reclamation Cannot Be Considered Merely Descriptive When The Patent And Trademark Office Has Registered The Same Term For Services Which Consist Of A Display Function.**

Applicant draws the Examiner's attention to the below-identified Patent and Trademark Office registrations.

Copies of said registration records appear in Exhibit A attached hereto and incorporated by this reference.

Mark: ENVIRONMENTAL RECLAMATION SERVICES, INC.

Goods: Recycling services for empty laser cartridges, empty inkjet cartridges, cell phones, and other electronic products.

Status: Registered

Fed. Reg. No. 3,008,841

Mark: AIM INC ON SITE RECLAMATION

Goods: Reclamation of bulk contaminated industrial fluids.

Status: Registered

Fed. Reg. No. 2,799,812

The above registrations incorporate the term "RECLAMATION" as does the instant application. Said registrations evidence a determination by the Patent and Trademark Office that is not descriptive. Moreover, all subject registrations cover services which relate to Applicant's services. It further appears that all subject registrations have a disclaimer that no claim is made to the words of mark except as shown in the mark. It is difficult for Applicant to understand why Serial No. 78/556,095 is the subject of an apparently more stringent and inconsistent standard of review than the above-listed registrations. Applicant respectfully requests examination of subject application in a manner consistent with earlier determinations made by the Patent and Trademark Office, wherein at minimum a disclaimer may be filed such that no claim to AT STORE RECLAMATION is made apart from the mark as shown.

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**G. AT STORE RECLAMATION Is Such A Broad Term That It Does Not Convey An Immediate Idea Of The Qualities Or Characteristics Of The Services And Is, Therefore, Not Merely Descriptive.**

Using the example of other registered marks listed above, AT STORE RECLAMATION is at least as broad a term as ON SITE RECLAMATION or ENVIRONMENTAL RECLAMATION SERVICES. Because the Mark is susceptible to a number of possible meanings, including a number of possible site-specific reclamation services unrelated to inventory control and reclamation of unsalable grocery products, the mark is not merely descriptive, but also functions to identify the origin of the services. As the mark is *not* merely descriptive, it should be registered.

**H. The Mark Is Not Used As An Adjective To Describe The Merit, Quality Or Attribute Of Applicant's Services Set Forth In The Application.**

AT STORE RECLAMATION does not tell any potential purchaser anything about the merit, quality or attribute of the services Applicant provides. In contrast, various courts have held a mark to be merely descriptive when it is used as an adjective, but where a mark also functions to identify the source of the goods or services, the courts have been more lenient. For example, in *Electropix v Liberty Livewire Corp.*, 178 F.Supp. 2d 1125, 60 U.S. P.Q.2d (BNA) 1346 (C.D. Cal. 2001), the Court held that “Live Wire” was not used as to describe a quality of the defendant’s products. 178 F. Supp. at 1129-30. The court used two other cases to illustrate the point. First, in *Colgate-Palmolive v. Carter-Wallace, Inc.*, 58 C.C.P.A. 735, 432 F.2d 1400 (1970), the court held that “Peak” in “Peak Period” is suggestive as applied to personal deodorant. *Electropix*, 178 F.Supp at 1129-30. Second, in *Platinum Home Mortgage Corp. v. Platinum Fin. Group, Inc.*, 149 F.3d 722 (7<sup>th</sup> Cir. 1998), the court held that “Platinum” in “Platinum Home Mortgage Corp.” is merely descriptive because it describes the quality of the mortgage services and suggests that it provides a superior service. *Electropix*, 178 F. Supp at



1130. The court opined that where words in there common, everyday usage describe the nature of the goods or services – as in “platinum” which connotes “the highest quality of something or reaching the highest level” – such a mark would be merely descriptive. *Id.*

The opinion in *Electropix* is illustrative here. The words AT STORE RECLAMATION do not describe any merit, quality or attribute of the services Applicant provides. Without such adjectival force, the Mark is not merely descriptive.

**I. Doubts Should Be Resolved In Applicant's Favor.**

Because the line between descriptive and suggestive marks can be nebulous, the Trademark Trial and Appeal Board has held that doubts about the merely descriptive nature of a term arising under Section 2(e)(1) must be resolved in favor of the applicant. In re Conductive Systems, Inc., 220 U.S.P.Q. 84 (TTAB 1983); In re Gourmet Bakers, Inc., 173 U.S.P.Q. 565 (TTAB 1972) (THE LONG ONE held not descriptive of bread); In re Morton-Norwich Products, Inc., 209 U.S.P.Q. 791 (TTAB 1981) (COLOR CARE not descriptive for laundry bleach); In re Pennwalt Corp., 173 U.S.P.Q. 317 (TTAB 1972) (DRI-FOOT is not merely descriptive).

Applicant requests all such doubts to be resolved in its favor.

**III. RECITATION OF SERVICES:**

Applicant has amended the recitation of services based in part upon the suggested language provided by the Examiner. Despite amending the recitation to coincide with the Examiner's suggestions, Applicant's recitation continues to be refused on the grounds that it is unclear and indefinite. Applicant did not adopt the exact language proposed by the Examiner; instead, the description of services was amended to that which was used in Applicant's prior application number 78/556,134, which is now allowed.

Specifically, the Examiner takes exception with the terminology “inventory control

services, namely, unsaleable damaged goods reclamation services.” Applicant respectfully points out, as noted above, that this exact description of services was previously allowed. Applicant is unclear why the Examiner has rejected language which has been expressly approved for the same mark elsewhere.

In the alternative, should the Board concur with the Examiner that the above recitation of services is not acceptable, Applicant amends the recitation in accord with the express language proposed by the Examiner in his April 17, 2006 Office Action, said amendment to read in its entirety:

Inventory control services, namely reclamation of damaged and unsaleable grocery and consumer goods for destruction or further disposition, in International Class 35.

### **CONCLUSION**

The Examining Attorney bears the burden of making out a persuasive case for finding that Applicant’s mark is *merely* descriptive. The instant case is predicated upon the assumption that the Mark specifically describes a feature, function, use, benefit and/or characteristic of Applicant’s services and/or that it describes or suggests the merit, quality and other attributes of Applicant’s services. In this case, the Examining Attorney has not carried the burden. Applicant’s mark requires elements of imagination, thought and perception for a consumer to reach a conclusion as to the nature of Applicant’s services. While the words AT STORE and RECLAMATION suggest the types of services provided, it requires this extra imagination on the part of the consumer regarding the types of services offered and the channels of trade within which the services are provided. Thus, the Mark does function to identify the source of the services and is not, then, *merely* descriptive. For the reasons set forth herein, Applicant submits

that its Mark is not merely descriptive and the Examiner's decision should be reversed and Applicant's application passed to publication.

Respectfully submitted,  
Schmeiser, Olsen & Watts LLP  
Counsel for Applicant

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Dated: December 18, 2006



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<b>Word Mark</b>	AIM INC ON SITE RECLAMATION
<b>Goods and Services</b>	IC 040. US 100 103 106. G & S: Reclamation of bulk contaminated industrial fluids. FIRST USE: 20020201. FIRST USE IN COMMERCE: 20020201
<b>Mark Drawing Code</b>	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
<b>Design Search Code</b>	16.03.25 - Crosshairs; Gun sights; Viewers, slide, hand-held 21.03.12 - Dart boards; Targets, bulls-eye 26.17.01 - Bands, straight; Bars, straight; Lines, straight; Straight line(s), band(s) or bar(s) 26.17.04 - Bands, vertical; Bars, vertical; Lines, vertical; Vertical line(s), band(s) or bar(s) 26.17.05 - Bands, horizontal; Bars, horizontal; Horizontal line(s), band(s) or bar(s); Lines, horizontal 26.17.25 - Other lines, bands or bars
<b>Serial Number</b>	76428167
<b>Filing Date</b>	July 5, 2002
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	October 7, 2003
<b>Registration Number</b>	2799812
<b>Registration Date</b>	December 30, 2003
<b>Owner</b>	(REGISTRANT) Advanced Industrial Maintenance, Inc. CORPORATION OHIO 1710 Irish Run Rd. Dennison OHIO 44621
<b>Attorney of Record</b>	Brent L. Moore
<b>Disclaimer</b>	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "INC." and "ON SITE

Type of Mark RECLAMATION" APART FROM THE MARK AS SHOWN  
Register SERVICE MARK  
Live/Dead Indicator PRINCIPAL  
LIVE

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<b>Word Mark</b>	ENVIRONMENTAL RECLAMATION SERVICES, INC.
<b>Goods and Services</b>	IC 040. US 100 103 106. G & S: Recycling services for empty laser cartridges, empty inkjet cartridges, cell phones, and other electronic products. FIRST USE: 20030901. FIRST USE IN COMMERCE: 20030901
<b>Mark Drawing Code</b>	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
<b>Design Search Code</b>	24.15.02 - Arrows forming any other geometric figure 24.15.10 - Arrows, more than one; More than one arrow 24.15.25 - Other arrows 26.01.15 - Circles, three or more; Three or more circles 26.01.21 - Circles that are totally or partially shaded. 26.05.09 - Triangles made of geometric figures, objects, humans, plants or animals
<b>Serial Number</b>	78474900
<b>Filing Date</b>	August 27, 2004
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	August 2, 2005
<b>Registration Number</b>	3008841
<b>Registration Date</b>	October 25, 2005
<b>Owner</b>	(REGISTRANT) ERS Imaging Supplies, Inc. CORPORATION PENNSYLVANIA 2101 West 12th Street Erie PENNSYLVANIA 165054839
<b>Attorney of Record</b>	Edward W. Goebel, Jr.

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "ENVIRONMENTAL RECLAMATION SERVICES, INC" APART FROM THE MARK AS SHOWN

**Type of Mark** SERVICE MARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

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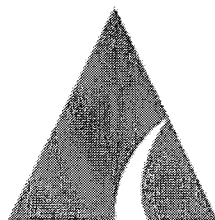
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<b>Goods and Services</b>	IC 037. US 100 103 106. G & S: INVENTORY CONTROL SERVICES, NAMELY, UNSALABLE DAMAGED GOODS RECLAMATION SERVICES
<b>Mark Drawing Code</b>	(2) DESIGN ONLY
<b>Design Search Code</b>	26.05.12 - Triangles with bars, bands and lines 26.05.21 - Triangles that are completely or partially shaded 26.17.09 - Bands, curved; Bars, curved ; Curved line(s), band(s) or bar(s); Lines, curved
<b>Serial Number</b>	<b>78556134</b>
<b>Filing Date</b>	January 28, 2005
<b>Current Filing Basis</b>	44E
<b>Original Filing Basis</b>	1B;44D
<b>Published for Opposition</b>	February 21, 2006
<b>Registration Number</b>	3092615
<b>Registration Date</b>	May 16, 2006
<b>Owner</b>	(REGISTRANT) Alternative Processing Systems, Inc. CORPORATION CANADA 60 Wingold Avenue Toronto, Ontario CANADA M6B 1P5
<b>Attorney of Record</b>	Albert L. Schmeiser
<b>Priority Date</b>	August 12, 2004
<b>Description of Mark</b>	The mark consists of Stylized A and design.
<b>Type of Mark</b>	SERVICE MARK
<b>Register</b>	PRINCIPAL
<b>Live/Dead Indicator</b>	LIVE



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